

RESPONSE TO OFFICE ACTION

A. Status of the Claims

Claims 1-24 were filed and the claims amended herein. Support for the amendments is found in the claims as filed. Reconsideration of the claims is respectfully requested.

B. Objection to the Specification and Claims

The Action objects to the specification and claims for including blank lines. In response, it is noted that corresponding information for a biological deposit of seeds of the claimed variety will be inserted in the specification and claims. The objection is thus believed moot and removal thereof is respectfully requested.

C. Rejection of Claims Under 35 U.S.C. §112, Second Paragraph

The Action rejects the claims under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out the subject matter which Applicants regard as the invention. The individual rejections and Applicants' responses thereto are set forth below

(1) The Action asserts that claim 6 is indefinite for its recitation of "corn plant of claim 2, further comprising a nuclear or cytoplasmic gene conferring male sterility" as it is asserted that this is inconsistent with claim 2.

In response, Applicants note that this rejection has already been decided in Applicants favor by the Board of Patent Appeals in a substantively identically worded claim in an application presenting the same operative facts. In particular, in Appeal No. 2005-0396, Application No. 10/077,589, the same rejection was made and reversed. In

that case claim 16 read as follows “16. The corn plant of claim 15, further comprising a nuclear or cytoplasmic gene conferring male sterility.” The Examiner rejected the claim on the same grounds as here, namely that the claim was inconsistent with the claim from which it depended. The Board reversed the rejection, stating that:

For example, claim 16 reads on a corn plant capable of expressing all the physiological and morphological characteristics of the corn variety I180580, further comprising a nuclear or cytoplasmic gene conferring male sterility. In our opinion, the claims reasonably apprise those of skill in the art of their scope. *Amgen*, As set forth in *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985), ‘[i]f the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.’ Accordingly we reverse the rejection of claims 16 and 27-30 under 35 U.S.C. § 112, second paragraph.

Exhibit A at p. 12

As explained by the Board, the claim is fully definite. In view of the Board’s decision on this issue, removal of the rejection is respectfully requested.

(2) The Action asserts that in claim 11 “capable of” is indefinite because it is unclear whether the plant does or does not express the physiological or morphological traits of the claimed variety.

The same rejection was made and reversed in Appeal No. 2005-0396. In that case claim 20 read as follows “20. A corn plant regenerated from the tissue culture of claim 17, wherein the corn plant is capable of expressing all of the physiological and morphological characteristics of the corn variety designated I180580, wherein a sample of the seed of the corn variety I180580 was deposited under ATCC Accession No. PTA-3224..” The Examiner rejected the claim on the same grounds as here, namely that because the claims use the term “capable” the claims do “not make clear if the plant

actually expresses the traits, or when or under what conditions the traits are expressed.”

The Board reversed, explaining that

To address the examiner’s concerns, we find it sufficient to state that if a plant has the capacity to express the claimed characteristics it meets the requirement of the claim regarding ‘capable of,’ notwithstanding that due to a particular phase of the life cycle the plant is not currently expressing a particular characteristic. Alternatively, if a plant is incapable of expressing the claimed characteristics at any phase of the life cycle, because it lacks, for example, the ‘transcription factor’ required for expression - such a plant would not meet the requirement of the claim regarding “capable of.”

Here, we find the examiner’s extremely technical criticism to be a departure from the legally correct standard of considering the claimed invention from the perspective of one possessing ordinary skill in the art. In our opinion, a person of ordinary skill in the art would understand what is claimed. *Amgen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991). We find the same to be true for the phrase ‘capable of’ as set forth in claims 17 and 20.

Exhibit A at p. 11.

The issue has therefore been resolved by the Board on the same facts and circumstances. Removal of the rejection is thus respectfully requested.

(3) The Action rejects claim 15 as confusing for recitation of “corn plant of claim 2, further comprising a transgene” which is said to be inconsistent with claim 2.

The same issue was considered and decided in Applicants favor in Appeal No. 2005-0396. In that case, claim 27 read as follows “27. The corn plant of claim 5, further defined as having a genome comprising a single locus conversion.” The Examiner rejected the claim on the same grounds as here, namely that “the examiner finds it unclear whether the plant set forth in claim 27 has all the characteristics of the plant set forth in claim 5, from which claim 27 depends.” **Exhibit A** at p. 12.

In response to the rejection of this and another claim (16) the Appellants noted that the claims simply add a further limitation to the claims from which they depend. The Board reversed the examiner and explicitly agreed with Appellants, stating that:

For example, claim 16 reads on a corn plant capable of expressing all the physiological and morphological characteristics of the corn variety I180580, further comprising a nuclear or cytoplasmic gene conferring male sterility. In our opinion, the claims reasonably apprise those of skill in the art of their scope. *Amgen*, As set forth in *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985), '[i]f the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.'

Exhibit A at p. 12.

The same issue as presented here has therefore been resolved by the Board in Applicants favor. Removal of the rejection is thus respectfully requested.

(4) Claim 19 is said to be indefinite for recitation of "said genome... comprising the genetic locus" on the basis that a locus is a position on a chromosome rather than a piece of DNA or a gene.

In response, Applicants note that the claim and claims dependent thereon have been amended to eliminate the issue and that the amendments render the rejection moot. Removal of the rejection is thus respectfully requested.

(5) The Action rejects claim 20 as indefinite for recitation of "genetic locus was stably inserted into a corn genome" on the basis that a locus is a position on chromosome and that it is unclear whether the locus is inserted into the plant of claim 20 or another plant.

With regard to the first issue, it is noted that this has been eliminated by the claim amendments. With respect to the second issue, Applicants note the position taken has

already been rejected by the Board of Patent Appeals in Appeal No. 2005-0396. In that case, claim 28 read as follows “28. The corn plant of claim 27, wherein the single locus was stably inserted into a corn genome by transformation.” The Examiner rejected the claim on the same grounds as here, namely that “the recitation does not make clear if the genome is that of [the claimed variety] or that of a different corn plant.” **Exhibit A** at p.

13. The Board reversed, explaining that

we agree with appellant (Brief, page 9) ‘[t]he single locus referred to in claim 28 may or may not have been directly inserted into the genome of the claimed plant.’ As we understand the claim, and arguments of record, claim 28 presents two possibilities: (1) the single locus is directly inserted into the claimed plant and nothing further need be done; or (2) the single locus is directly inserted into a different plant, which is then used to transfer the single locus to the claimed plant through use of the plant breeding technique known as backcrossing.

In our opinion, the claim reasonably apprises those of skill in the art of its scope. *Amgen*. Accordingly, we reverse the rejection of claim 28 under 35

Exhibit A at p. 13-14.

The issue has therefore been resolved by the Board. Removal of the rejection is thus respectfully requested.

(6) The Action rejects claim 21 on the basis that “locus is selected ... dominant allele and a recessive allele” is confusing since a locus is a location on the genome not an allele.

In response, Applicants note that the claim has been amended and that the amendment renders the rejection moot. Removal of the rejection is thus respectfully requested.

D. Rejection of Claims Under 35 U.S.C. §112, First Paragraph - Enablement

1. Rejection of claims 1-24

The Action rejects claims 1-24 under 35 U.S.C. §112, first paragraph, for lack of a seed deposit. In response, Applicant notes that a deposit of 2,500 seeds of the claimed variety will be made with the ATCC in accordance with all of the relevant rules. A declaration certifying that the deposit meets the criteria set forth in 37 C.F.R. §1.801-1.809 will be provided and the claims amended to recite the corresponding accession number. The specification will also be amended to include the accession number of the deposit and the date of deposit.

2. Rejection of claims 6, 11 and 15-24

The Action rejects claims 6, 11 and 15-24 as not enabled. The claims are directed to hybrid corn seeds or plants having the claimed inbred variety as a parent, corn plants of the claimed variety which comprise a conversion or a nuclear or cytoplasmic gene conferring male sterility and methods of producing such plants. The Action alleges that no guidance has been provided for creation of such plants and asserts non-enablement because absolute purity of backcrossed progeny may not be retained.

a. Rejection of claims 23-24

The rejection of claims 23-24 does not survive even the most basic scrutiny. Claim 23 is directed to a hybrid seed having the claimed variety as one parent. This seed is produced by the method of claim 13. The Action acknowledges enablement for the method of claim 13 by not including the claim in the rejection. If the method of claim 13 is enabled so is the product produced by the method. Further, claim 24 is directed to a plant produced by growing the seed of claim 23. This can be produced by literally no more than placing the seed in the ground and is therefore also enabled. In sum, there is

not even a colorable argument that these rejections can be properly maintained. Removal of the rejections is thus respectfully requested.

b. Enablement is demonstrated in the specification

The specification includes a working example describing a conversion that was made with a proprietary corn variety. This example gives the breeding history of the conversion that was made, including a description of seven backcrosses. The example describes exactly the type of process one of skill in the art could use to prepare conversions of the instant variety. The specification provides in great detail further guidance for creation of converted plants at pages 29-33. The techniques recited are also all well known in the art (*e.g.*, Poehlman *et al.*, 1995; Fehr, 1987; Sprague and Dudley, 1988). No basis has been provided to demonstrate why this example alone is not fully enabling as the procedures used in the example may be used to introgress any other trait within the scope of the claims.

With regard to creation of male sterile plants, this is also a technique that has been well-known for decades. This is evidenced by the numerous issued patents for creation of male sterile plants (see U.S. Patent No. 3,861,709; U.S. Patent No. 3,710,511; U.S. Patent No. 4,654,465; U.S. Patent No 5,625,132; U.S. Patent No. 4,727,219; U.S. Patent No. 5,530,191; U.S. Patent No. 5,689,041; U.S. Patent No. 5,741,684; and U.S. Patent No. 5,684,242). This evidence therefore establishes the enablement of the claims and no basis to conclude otherwise has been provided as set forth below.

**c. The References Cited Fail to Provide a Basis for the Rejection
and Affirmatively Demonstrate Enablement of the Claims**

The basis alleged by the Action for the rejection is a citation to a number of references said to show the difficulty of making male sterile or converted plants. These references do not support the rejection and in fact affirmatively demonstrate the enablement of the claims.

For example, the Action cited Murray *et al.* (pp72-87, *Proc. 43rd Annual Corn and Sorghum Industry research*, Wilkinson *et al. eds.* 1988 American Seed Trade Assn.) for the proposition that linkage drag is common in corn breeding, that the “equivalent” of 10 backcrosses resulted in retention of 10% of the “unwanted” donor parent genome, this material would not be lost without backcrossing and selection, and that molecular marker assisted breeding or pedigree determination in corn is unpredictable due to a failure to identify markers specific for particular cultivars. Applicants traverse as the statements made regarding this **1988** reference both selectively misquote the teachings while ignoring directly contradictory statements and have no negative bearing on enablement.

The sections at page 82-84 cited for the proposition that linkage drag is common and regarding the “equivalent” of 10 backcrosses are misleading, for example, because in fact the authors indicate that only six backcrosses were carried out yet the authors were able to obtain plants that “approximated BC 10 in terms of inbreeding equivalence.” Murray at p. 82, 2nd full ¶. There is further no basis to conclude why any additional number of generations of backcrossing would require undue experimentation. The examples in the specification mentioned above shows seven generations and any

additional number of generations could be carried out using the most basic of experimentation.

Murray was also published in *1988*, which Applicants submit is in no way indicative of the state of the art as of the filing date of the current application. As of March, 2002 the public USDA linkage map for maize included at least 1,006 RFLP and 804 SSR loci. In contrast, Murray states that “the current Agrigenetics maize RFLP linkage map consists of 300 independent loci.” See p. 74, legend of Fig. 2; see also http://www.ars.usda.gov/research/publications/publications.htm?SEQ_NO_115=136896.

Despite the relatively unadvanced state of the art at the time Murray *et al.* was published, the reference in fact affirmatively establishes enablement. Murray *et al.* note, for example, that:

Polymorphism is relatively easy to detect in maize for several reason. First, maize exhibits considerable genetic variability. Second transposition, a predominant feature of maize genome evolution, generates easily detectable polymorphism []. However, transposition is not frequent enough to cause problems in the stability and utility of most probes []. Thus, in contrast to other crops such as tomato, soybean and lettuce [], it is possible to construct maize genetic maps using only a few different restriction enzymes.

Murray at p. 76, 2nd full ¶, (citations omitted; emphasis added). Still further, just above a portion cited in the Action, the reference notes the following:

Heretofore, the process of genome recovery could only be estimated by phenotype, statistical expectation, and expensive combining ability tests. RFLP technology, on the other hand, ***reveals the mosaic of parental chromosome segments*** within each individual, thus ***permitting the breeder to select with accuracy never before possible***.

Murray at p. 82, 1st full ¶ (emphasis added).

Finally, Murray states in another section flanking a portion cited in the Action as showing problems associated with linkage drag that:

The longstanding concept of using markers flanking a desirable gene to circumvent these problems is now practical with RFLP markers. *Individuals in which recombination has occurred optimally close to the desired locus can be identified and thus linkage drag can be greatly reduced.* This technique would involve searching among a progeny with the RFLP assay to discover individuals in which the desired recombination has occurred, and then using these individual for the next backcross []. In addition, any *extraneous segments could be easily identified* or at least tested for their contribution to phenotype.

Murray at p. 84, 2nd full ¶ (citation omitted; emphasis added). This section in and of itself establishes that all of the other assertions regarding an inability to introgress a locus conversion are completely unfounded and that those of skill in the art knew how to introgress such a conversion at least as of the **1988** publication of this paper, even using the relatively lightly populated RFLP map that existed at the time. All that is required to eliminate linkage drag is to select those individuals with recombinant segments. As stated by Murray, even as of the 1988 publication date markers readily be used to carry this out. As of the filing date of this application, extensive public marker maps existed with at least 1,006 RFLP markers in addition to 804 SSR markers, which are both highly informative and amenable to high-throughput screening via PCR. Enablement is thus demonstrated by this reference.

With regard to the Kevern (US 5,850,009) and Carlone (US 5,763,755) references, these are irrelevant to enablement because the teachings cited do not even relate to backcrossing or introgression of a locus conversion but rather relate to production of new inbred lines. See col. 4, l. 37-46 of Kevern and paragraphs bridging cols. 1-2 of Carlone. Neither reference states that backcrossing or introgression of traits is unpredictable. In fact, Carlone states that “backcrossing for example, can be used to improve an inbred line” and that “[b]ackcrossing can be used to transfer a specific desirable trait from one inbred or source to an inbred that lacks that trait.” Col. 3, l. 4-7.

The reference even teaches a method for accomplishing this and states that selfing in the last backcross generation gives pure breeding progeny for the gene(s) being transferred. Col. 3, lines 4-21. These references contain no information suggesting non-enablement of the claims and again demonstrate that backcrossing was routine in the art.

The Action next cites Goldman *et al.* (*Crop Sci.*, 34:908-915, 1994) for the proposition that use of molecular markers to facilitate identification of chromosomal regions associated with quantitatively inherited traits is hampered by different linkage groups with different parents or that quantitative traits such as oil or protein content are inversely proportional to kernel size. In response, Applicants note again that the teaching and relevance of the reference have been misstated. This **1994** reference did not concern introgression of a trait into a starting genotype but rather involved mapping of complex QTLs in a population derived from the same starting line, the open pollinated variety Burr's White. See p. 909, col. 1, 1st ¶. Given the common ancestry it is not surprising that some markers were shared. Despite this, the conclusions drawn from the results of the studies is that "Results from this investigation demonstrate the effectiveness of identification of QTL for oil concentration and kernel weight in a population descended from a cross of two strains divergently selected for protein concentration. Quantitative trait loci for oil were detected despite a relatively narrow range of oil concentration." See. "Conclusions" starting at p. 913, col. 2, last ¶. Therefore, if any conclusions can be drawn they are in favor of the ability to use marker assisted selection rather than against. Finally, with regard to the assertion that some traits are associated with kernel size, Applicants note that this is completely irrelevant. The claims do not require any

particular kernel size and the end size of any kernel produced by backcrossing is irrelevant to whether one of skill in the art could make or use what is claimed.

Next, Stuber (*Crop Sci.* 17(4):503-506, July, 1977), is cited for the proposition that corn breeding is confounded by epistasis and that grain and ear number were strongly affected by environment. In response, Applicants note that this **1977** reference was published so long ago as to be completely useless in drawing any inferences about what the state of the art was as of the filing date. Further, the reference relates to hybrid plant performance, not locus conversions or backcrossing. See Abstract at p. 503. The reference is therefore irrelevant to the claims.

Finally, Melchinger (*Theor. Appl. Genet.*, 72:231-239, 1986) is cited for the proposition that epistasis reduced the amount of heterosis (hybrid vigor) in hybrid crosses. In response, Applicants note that, in addition to being published so long ago as to be useless, the reference is completely irrelevant. The claims do not require any level of heterosis nor is any such requirement made by any patent law. All that is required for enablement is objective enablement, not any particular level of efficacy. *In re Marzocchi*, 169 UPSQ 370 (CCPA 1971). Thus, even if the assertions made were taken as true, which is not conceded, this has no relevance to the claims or enablement.

d. Conclusion

In conclusion, the references cited fail in any way to suggest non-enablement of the claims and further establish that it was routine in the art as of at least 1988 to introgress a locus conversion into a plant using backcrossing and marker assisted selection. This requires only the most routine of experimentation following the techniques described in the specification. Further, it has been held that in fields such as

this where the art typically engages in experimentation and knows how to carry out such experimentation even complex experimentation is not undue. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). In the current case, corn breeding is extremely advanced and well known in the art. As explained in the specification, North American farmers alone plant *tens of millions of acres* of corn at the present time and there are *extensive national and international commercial corn breeding* programs.

In sum, no basis has been provided to conclude why anything other than routine experimentation using the well known techniques would be required. The enablement of the claims has therefore been established and removal of the rejection is respectfully requested.

E. Rejection of Claims Under 35 U.S.C. §112, First Paragraph – Written Description

The Action rejects claims 6, 11 and 15-24 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to convey that Applicants were in possession of the claimed invention. For example, it is asserted that a plant of the claimed variety comprising a male sterility gene or locus conversion, F1 hybrid progeny of the claimed variety and methods of plant breeding comprising use of the claimed variety as starting material lack written description.

In response Applicants note that all of the rejections made have specifically been considered and reversed by the Board of Patent Appeals on the same subject matter

presented in the current case. The rejections must be removed on the same basis as provided by the Board, as explained below.

In addition to Appeal No. 2005-0396, discussed above, the Board of Patent Appeals decided five other substantially similar appeals on March 31, 2005 brought by the current Real Party in Interest: Appeal Nos: 2004-1503 (Ser No. 09/606,808), 2004-1506 (Ser. No. 09/788,334), 2004-1968 (Ser. No. 10/000,311), 2004-2317 (Ser. No. 09/771,938), and 2004-2343 (Ser. No. 09/772,520) (collectively “the corn variety appeals”). The issues decided in these cases were the same as those raised by the current case. Each of the prior cases and the current case had the same Supervisory Patent Examiner and were examined in Group 1638. Essentially identical written description rejections were raised in the prior cases relative to the current case.

In the corn variety appeals, for example, rejections were raised based on an alleged lack of written description for F1 hybrid plants. Specifically, it was alleged that the F1 hybrid plants only have as half of their genome the genome of the parent plant of interest and the remaining portion was not described, and thus written description is lacking, despite the fact that no particular second hybrid plant is required by the method. *See Exhibit A* at p. 17.

The Board rejected this reasoning, noting that, as here, the claims require no particular second parent of the F1 hybrid and the Examiner had already acknowledged written description for the variety of interest. The Board also specifically disagreed with the Examiner’s assertion that the fact that any hybrid plant will inherit half of its alleles from the parent variety does not provide sufficient description of the morphological and physiological characteristics expressed by the claimed hybrid plants. *Id.* The Board thus

held that “there can be no doubt that the specification provides and adequate written description of this corn variety.” *Id.* at p. 18. As explained by the Board, the purpose of the written description requirement is to “ensure that the right of the scope to exclude, as set forth in the claims does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.” *Id.*

Here, as in the corn variety appeals, the claimed F1 hybrid plants must have the admittedly described variety of interest as one parent, and thus the claims do not overreach the scope of the inventor’s contribution and are fully described. The Board rejected the notion that an Applicant must define every possible second parent plant of a hybrid cross and the morphological characteristics of the progeny to provide written description for claimed hybrid plants. In particular, the Board stated that it “disagree[d] with the examiner’s conclusion (*id.*) that ‘[t]he fact that any hybrid plant will inherit half of its alleles from [the variety of interest] then does not provide sufficient description of the morphological and physiological characteristics expressed by the claimed hybrid plants.’” *Id.*

Methods of plant breeding are similarly described. Essentially identical written description rejections were raised by the examiner in Appeal No. 2005-0396 of claims drawn to a method of breeding corn plants comprising use of the variety of interest as starting material. In the appeal the Examiner argued that written description is lacking because the intermediate plants at each step of the method allegedly must be described to satisfy written description and that such plants had not been defined, regardless of the fact that the only starting material required by the claims was the variety of interest, which was admittedly fully defined. *See* p. 12-15. The Board rejected this reasoning,

noting that, given the acknowledgement of written description for the variety of interest, appellants were also in possession of a method of using that plant for crossing with any other plant to produce an inbred plant as set forth in the claims. See **Exhibit A** at p. 24 (“Therefore, in our opinion, there can be no doubt that appellant was in possession of a plant of the corn variety 1180580, in addition to a method of using that plant to cross with any other corn plant to produce an inbred corn plant as set forth in appellant’s claim 31”). The Board thus concluded that appellant established with reasonable clarity that they were in possession of the invention. In the context of methods of introducing transgenes, the Board noted that no evidence was provided to support the rejections or inadequacy of written description for the claims. The Board thus reversed the written description rejections.

The same issues have been presented here and raised in the Office Action. As the Board has already decided all of the rejections made here in Applicants favor in the corn variety appeals, removal of the rejection is respectfully requested.

F. Rejection Under 35 U.S.C. §102

The Action rejects claim 11 under 35 U.S.C. §102(b) as being anticipated by a patent said to teach some of the traits of the claimed variety. Applicants respectfully traverse as no showing that the reference actually does teach the claim limitations or for concluding that such properties are inherent has been made on the record. No basis for shifting the burden on the Applicants has further been shown because the claims fully distinguish over the prior art. For example, claim 11 is directed to a corn plant that is capable of expressing all of the physiological and morphological characteristics of the claimed corn variety. Absolutely no basis for concluding that any prior art plant is

capable of expressing these characteristics has been provided and the characteristics of the claimed variety are already admittedly novel. Hypothetical possibilities in a rejection do not suffice as explained below.

The Action appears to be alleging that the cited plant *may* be the same as the claimed variety, listing several traits that appear to be the same. However, other than the recitation of a few selected traits, the Action made no attempt to show that the cited variety anticipates the subject matter of the claims. Under 35 U.S.C. § 102(b) it is the burden of the Office to show that *each and every* element as set forth in the claim is found in the prior art. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). This has not been done and the anticipation rejection must therefore fail.

To the extent that unexpressed inherent characteristics of the cited variety form the basis of the anticipation rejection, it is noted by Applicants that these characteristics must necessarily flow from the prior art. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) ("To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."). Here, it is merely stated that the cited variety shares *some* of the same characteristics and there is

no showing that any other traits *are* necessarily present. The Action has thus failed to meet the burden under 35 U.S.C. §102.

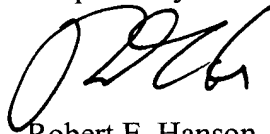
Finally, Applicants note that a rejection must be supported by “substantial evidence” in accordance with the Administrative Procedure Act (“APA”). 5 U.S.C. § 706(A), (E), 1994; *see also In re Zurko*, 59 USPQ 2d 1693 (Fed. Cir. 2001). The current rejection is not properly supported because it is based on hypothetical possibilities. The burden has further not been shifted to Applicants because the claims define over the prior art as set forth above. No basis for the rejection has therefore been provided or exists. Removal of the rejection is thus respectfully requested.

G. Conclusion

This is submitted to be a complete response to the referenced Office Action. In conclusion, Applicant submits that, in light of the foregoing remarks, the present case is in condition for allowance and such favorable action is respectfully requested.

The Examiner is invited to contact the undersigned at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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